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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,132	05/29/2001	Knut E. Rasmussen	01-11 US	9635

7590 06/16/2006

Varian Inc  
3120 Hansen Way M S D 102  
Palo Alto, CA 94304

EXAMINER

VENCI, DAVID J

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/857,132	RASMUSSEN ET AL.	
	Examiner	Art Unit	
	David J. Venci	1641	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**


A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on March 31, 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 42-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration. 
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on March 31, 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

Examiner acknowledges Applicants' reply, filed March 31, 2006. Applicants' amendment cancels claims 21-41 and 48-61.

Currently, claims 42-47 are under examination.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Specification*

The disclosure is objected to because of the following informalities. Appropriate correction is required.

Throughout the specification, the recitation of "liquid-liquid-liquid" is indefinite. The identity of three liquid species belonging to "liquid-liquid-liquid" is not clear.

On p. 11, last paragraph, second sentence, the recitation of "the hollow fibre" lacks antecedent basis.

On p. 12, third paragraph, sixth sentence, the recitation of "The hollow fibre" lacks antecedent basis.

In the paragraph bridging pp. 12-13, second sentence, the recitation of "The hollow fibre" lacks antecedent basis.

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### ***Drawings***

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to for the following reasons:

In Fig. 4, the abbreviation "LLMBE" is not clear.

***Claim Rejections - 35 USC § 112***

Claims 42-47 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Specifically, the identity of objects and/or steps, if any, required for performing or establishing "equilibrium" is not clear. Applicants' invention, as claimed, does not appear to set forth any cooperative structural relationship between "membrane wall" and "acceptor solution", or whether a gradient is required for establishing "equilibrium".

Claim 42 is further rejected under 35 U.S.C. 112, second paragraph, as being indefinite because the passive voice recitation "equilibrium is established" is not clear. The identity of object(s) and/or step(s), if any, required for performing "establishing" is/are not clear. Whether the objects and/or steps required for "establishing" are coextensive with the objects and/or steps required for "stirring" is not clear.

***Claim Rejections - 35 USC § 102***

Claims 42-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross (US 3,429,785).

Ross describes a method comprising the steps:

- (1) providing a first container (see Fig. 6, container comprising test solution 72) having a sample solution (see Fig. 6, test solution 72) comprising a dissolved analyte (see Abstract, "ionic species");
- (2) providing a second container (see e.g., Fig. 1, ion sensitive electrode 20) with a membrane wall (see e.g., Fig. 1, membrane 22) having fiber pores (see e.g., col. 5, lines 17-18, "porous polyethylene");
- (3) filling the second container with an acceptor solution (see e.g., Fig. 1, ion exchanger liquid 24);
- (4) lowering the second container into the first container (see Fig. 6, container comprising ion sensitive electrode 50);
- (5) stirring the sample solution (see col. 8, lines 8-9, "[s]teady state conditions of potential were established");
- (6) removing analyte enriched acceptor solution (see col. 8, lines 10-11, "moving the electrode").

***Response to Arguments***

In prior Office Action, claims 42-47 were rejected under 35 U.S.C. 102(b) as being anticipated by Sirkar *et al.* (US 5,637,224). In response, Applicants amend independent claim 42 to add, *inter alia*, the step of “lowering the second container into the first container with the sample solution therein”. Applicants’ amendment and related argumentation are fully persuasive and sufficient to overcome this rejection. Accordingly, this rejection is withdrawn. Applicants’ argumentation on this issue has been rendered moot in view of the new ground(s) of rejection set forth, *supra*, *Claim Rejections - 35 USC § 102* in view of Ross (US 3,429,785).

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**Conclusion**

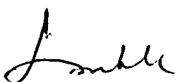
No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Venci whose telephone number is 571-272-2879. The examiner can normally be reached on 08:00 - 16:30 (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

David J Venci  
Examiner  
Art Unit 1641

djv

  
**LONG V. LE** 06/12/06  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**